

Serial No.: 09/683,233
Confirmation No.: 8299
Applicant: PONN, Helmut *et al.*
Atty. Ref.: 07574.0102.PCUS00

REMARKS

In response to the Office Action dated January 13, 2004, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1 and 5-7 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,092,845 to Koenig. Claims 2-4 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Koenig* in view of U.S. Patent 4,691,584 to Takaishi *et al.* The Applicant shows, however, that the pending claims are patentably distinguishable over the cited reference(s), and the Applicant thus respectfully submits that the pending claims are allowable.

Discussion with Examiner Lugo

Examiner Lugo discussed the substance of this response. On Wednesday, May 12, 2004 Examiner Lugo was called to discuss this response. The references to *Koenig* and to *Takaishi* were discussed, and the Applicant pointed out the distinguishing features of this invention. The Applicant pointed out that *Koenig*, in contradistinction to this invention, has the cable end engaging the cable seat in both the locked and the unlocked positions. The Applicant reviewed the portions of *Koenig* cited herein, and the Applicant reviewed how the Figures of *Koenig* show the cable end engaging the cable seat in the locked position. Examiner Lugo then suggested these arguments be formally presented in a Request for Reconsideration.

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Rejection Under 35 U.S.C. § 102 (b)

Claims 1 and 5-7 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,092,845 to Koenig. In response, Applicant requests that the Examiner reconsider and withdraw the rejection in view of the following remarks.

A claim is anticipated only if “each and every element” of the claimed invention is found either expressly or inherently described in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. (BNA) 81, 84 (Fed. Cir. 1986) (“absence from the reference of any claimed element negates anticipation.”); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d (BNA) 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d (BNA) 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *See ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d (BNA) 1321, 1328 (Fed. Cir. 1998). *See also In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d (BNA) 1655, 1657 (Fed. Cir. 1990). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter “M.P.E.P.”). As the Applicant shows, however, independent claim 1, and thus the dependent claims 5-7 thereunder, are patentably distinguishable over *Koenig*. The reference to *Koenig* does not anticipate this invention, so the Applicant respectfully requests that Examiner Lugo remove the 35 U.S.C. § 102 (b) rejection of claims 1 and 5-7.

Koenig does not anticipate independent claim 1. Claim 1 recites that “the cable end is directed for engagement with the cable seat in the unlocked position and *is directed to the side of the cable seat in the locked position*” (emphasis added). *Koenig*, in contradistinction to this

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invention, has the cable end engaging the cable seat in both the locked and the unlocked positions. *Koenig* discloses a “tension spring 56 has one of its ends 58 attached to a part of the mounting bracket 28 at 60 and its other end 62 attached to a part of lever 50 at attachment point 64” (U.S. Patent 6,092,845 to *Koenig* at column 3, lines 52-55). “*The tension of spring 56 acts to keep the rivet or bolt 68 in the end of the slot smaller part 80 opposite the larger slot end 78*” (*Koenig* at column 4, lines 1-3) (emphasis added). *Koenig* further explains that the tension in the spring 56 keeps the cable end 68 seated in the smaller part 80. Thus, unlike claim 1 of this invention, *Koenig* does not direct the cable end “*to the side of the cable seat in the locked position.*”

FIG. 2 of *Koenig* illustrates the cable end 68 in the locked position. As *Koenig* describes, FIG. 2 shows the latch mechanism in the “fully engaged or fully locked position” (column 2, lines 15-16, column 3, lines 9-10, column 5, lines 5-7, and column 5, lines 33-34). FIG. 2 of *Koenig* shows the cable end 68 engaging the smaller part 80. Even though *Koenig*’s locking mechanism does permit “slidable movement of the rivet or bolt 68 within the smaller part 80” (column 5, lines 22-23), *Koenig* explains that “tension in spring 56 moves the lever 50 in a clockwise direction” (column 5, lines 27-28), thus returning the cable end 68 to the smaller part 80 (as FIG. 2 shows). Thus, when *Koenig*’s locking mechanism is in the locked position, *Koenig* maintains the cable end 68 seated in the smaller part 80. *Koenig*, then, does not direct the cable end “*to the side of the cable seat in the locked position*” as claim 1 requires.

The dependent claims are also not anticipated; because *Koenig* does not anticipate independent claim 1, the dependent claims 5-7 are likewise unanticipated. The Applicant, then, respectfully asks Examiner Lugo remove the 35 U.S.C. § 102 (b) rejection of claims 5-7.

For the above reasons the Applicant submits that nowhere in the *Koenig* reference is there believed to be any disclosure or suggestion to modify the structure shown in a manner to achieve the claimed invention. In view of the above, Applicant requests the reconsideration and

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withdrawal of the rejection of Claims 1, and 5-7 under 35 U.S.C. § 102 (b). The Applicant also asks that the Examiner indicate the allowance of the claims in the next paper from the Office.

Rejection Under 35 U.S.C. § 103 (a)

Claims 2-4 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Koenig* in view of U.S. Patent 4,691,584 to Takaishi *et al.* The Applicant respectfully requests that the Examiner reconsider and withdraw the above rejection of the claims in view of the following remarks.

A determination under 35 U.S.C. § 103 (a) is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d (BNA) 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ (BNA) 459, 467 (1966), *see also Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370, 1376, 51 USPQ (BNA) 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d (BNA) 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d (BNA) 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not

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“evidence.” *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d (BNA) 1614, 1617. The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *See In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d (BNA) 1673, 1681 (Fed. Cir. 1988); *see also In re Longi*, 759 F.2d 887, 897, 225 USPQ (BNA) 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d (BNA) 1780, 1783-84 (Fed. Cir. 1992).

The examiner has the burden of establishing a *prima facie* case of obviousness. *See In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d (BNA) 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a *prima facie* case has been established. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d (BNA) 1955, 1957 (Fed. Cir. 1993). Only if the burden of establishing a *prima facie* case is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *See In re Deuel*, 51 F.3d 1552, 1553, 34 USPQ 2d (BNA) 1210, 1214 (Fed. Cir. 1995), *see also Ex parte Obukowicz*, 27 USPQ 2d (BNA) 1063, 1065 (B.P.A.I. 1992).

With the above legal guidelines reviewed, the Examiner should now appreciate the nonobviousness of this invention. Claims 2-4 and 8 are not obvious over *Koenig* in view of *Takaishi*. Claims 2-4 and 8 depend from independent claim 1. Claims 2-4 and 8 thus incorporate the same patentable features of independent claim 1. The combination of *Koenig* and *Takaishi* still fails to teach directing the cable end “to the side of the cable seat in the locked position” as claim 1 requires. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Koenig* and *Takaishi* to obviate this invention. Because the combination of *Koenig* and *Takaishi* does not teach or suggest all the claim limitations, the Applicant respectfully submits that the requirement and burden of presenting of a *prima facie* case of obviousness under 35 USC §103 (a) has not been presented. Therefore the Applicant requests the reconsideration and withdrawal of the rejection Claims 2-4 and 8 under 35 USC § 103 (a).

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Given the above, Applicant requests that the rejection of Claims 2-4 and 8 under 35 U.S.C. § 103 (a) be reconsidered and withdrawn and that the Examiner indicate the allowance of the claims in the next paper from the Office.

Allowable Subject Matter

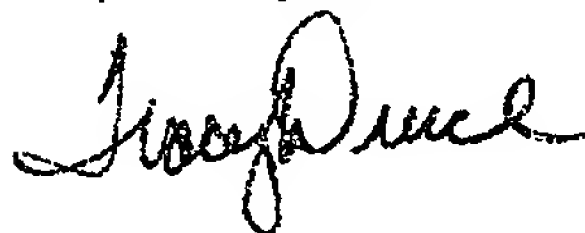
The designation of claims 9-17 as being allowed is acknowledged with appreciation.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, Order No. 07574.0102.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,



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